

Applicant: Volpe et al.
Application No.: 09/844,057

REMARKS/ARGUMENTS

After the foregoing amendments, claims 1,12, 20 and 23 are canceled, 2-11, 13-19, 21, 22 and 24-28 are pending in this application; claims 2-6, 9-11, 13, 15-17, 21, 22, and 24 are amended, and claims 25-28 were added. Applicants submit that no new matter has been introduced by these amendments.

Claim Rejections - 35 USC § 103(a)

Claims 1-3, 7-17 and 20-23 were rejected under 35 U.S.C. § 103 as being unpatentable over Gorbet (U.S. Pat. No. 6,072,480) in view of Raspberry Music World (<http://www.raspberryworld.com/music/burned.html>) (RWM).

As a first matter, Applicants respectfully submit that it is improper to make this Action final because it is based upon references cited for the first time. See MPEP § 706.07(a).

Further, claims may be rejected under 35 U.S.C. § 103 only if all of the references cited are prior art. See Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc., 424 F.3d 1293, 1321 (Fed. Cir. 2005) ("A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art"). The Action must identify the event that makes the references prior art; i.e., the date of publication, public

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performance, etc. See MPEP § 706.02(a), I (“The examiner must determine the issue or publication date of the reference so that a proper comparison between the application and reference dates can be made”); MPEP § 707.05(e), IV (outlining information to be provided by Examiner when citing electronic references).

Applicants respectfully submit that there is no evidence showing that RWM is prior art to the present application. The pages from RWM submitted with the Office Action are dated September 6, 2005. The present application was filed on April 27, 2001. Further, there is no indication that RWM was published or that there were any public performs prior to the filing date of the present application. The fact that songs were selected and placed on a compact disc does not mean that this compilation was performed or made public. Furthermore, a new date on a late publication cannot suffice to establish a stated earlier publication date. Because there is no showing that RWM is prior art to this application, the 35 U.S.C. § 103 rejection must be withdrawn along with the final action designation.

Even if RWM can be qualified as prior art, Applicants respectfully submit that the two cited references do not combine to render the present application obvious, especially in light of new claims 25-28. Gorbet discloses a “music engine” that controls “the composition and performance of a soundtrack that accompanies the currently displayed slide.” Applicant respectfully submits that display of slides accompanied by computer generated music, is not equivalent to the DJ performance

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as claimed in the present invention. The appearance of the slide is based entirely on the user's input. In other words, the display "performance" of the slide is exactly what the user inputs; i.e., the title, bullet points, etc. However, in the present invention, the DJ performance is based on the client specific information and the DJ's performance, which is comprised, in part of a typical DJ improvisational performance, such as the DJ announcing the song title before playing the song, or stating that a song was number one in a certain year, was record of the year, performer of the year, etc. Further, as made clear in new claims 25-28, the performance of the present invention is arranged with and among event specific comments and musical performances "such that a DJ like performance related to the future event is fixed on the recording media." Gorbet does not disclose or suggest that its slideshow contains any of these elements. Therefore, the slideshow "performance" of Gorbet is not similar to the DJ performance of the present invention.

Further, RWM does not disclose or suggest, explicitly or inherently, "client selected, event specific materials" nor does it disclose "a DJ like performance related to [a] future event" fixed on a recording media, as in new claims 25-28. (emphasis added). RWM discloses only a compilation of music on a compact disc. Further, even if this compilation "remind[s] us of different times in our lives" it does not teach that it is compiled for the purpose of performance at a specific, future event as

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do the claims of the present invention. Therefore, RWM does not render the claims of the present invention obvious alone or, in view of Gorbet.

Based on the foregoing, Applicant respectfully submits that new claims 25-28 are allowable over the prior art. As such claims 2-11, 13-19, 21, 22, and 24, which depend therefrom, are also allowable over the prior art. Withdrawal of the 35 U.S.C. § 103(a) rejection of is respectfully requested.

Claims 4, 18 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gorbet (U.S. Pat. No. 6,072,480) in view of Raspberry Music World (<http://www.raspberryworld.com/music/burned.html>) (RWM), further in view of Bakos (U.S. Pat. No. 6,511,728).

Applicants respectfully submit that in light of the above arguments and amendments, claims 25-28 are allowable over Gorbet and RWM. Therefore, claims 4, 18 and 24, which depend therefrom are also patentable over Gorbet and RWM. This obviates the 35 U.S.C. § 103(a) rejection with respect to Bakos.

Based on the arguments presented above, withdrawal of the 35 U.S.C. § 103 rejection of claims 4, 18 and 24 is respectfully requested.

Conclusion

Applicants request reconsideration and further examination of the application based on the above-referenced amendments and arguments. If the Examiner believes that an interview will advance prosecution of this application, at

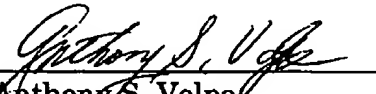
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the Examiner is invited to contact the undersigned to arrange an interview at the Examiner's convenience. If the Examiner believes that the foregoing amendments and arguments do not place the application in condition for allowance, Applicants respectfully request entry of the amendment for purposes of appeal.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the pending claims, following this amendment, are in condition for allowance and a notice to that effect is respectfully requested.

Respectfully submitted,

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